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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,804	10/12/2001	Kouji Seino	1448.1016	7763

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EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,804

Applicant(s)

SEINO, KOUJI

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 44-86 have been examined. Application 09/974,804 (METHOD OF AND APPARATUS FOR DISTRIBUTING INFORMATION, AND COMPUTER PRODUCT) has a filing date 10/12/2001 and foreign data 06/28/2001.

Response to Amendment

2. In response to Non Final Rejection filed 06/28/2005, the Applicant filed an Amendment on 09/28/2005, which cancel claims 1-43 and added new claims 44-86.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 44-86 recites "a compiling unit that compiles the electronic articles" and also recites "re-compiling of the electronic articles". Nowhere, in the Applicant's specification said limitations are explained or mentioned.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45, 58 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claims 45, 58 and 73 recites "the compiling unit compiles the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit". Nowhere, in the Applicant's specification said limitation is explained or mentioned. For purpose of art rejection, said limitation would be interpreted as meaning "updating the content of said electronic articles".

Claims 46, 60 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 46, 60 and 75 recites ""or a second number of times an advertisement is compiled by the compiling unit". Nowhere, in the Applicant's specification said limitation is explained. For purpose of art rejection, said limitation would be interpreted as "updating the advertisements".

Claims 47, 53, 68 and 83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Previous claims recites "a website notifying unit that notifies the website to which electronic articles compiled by the compiling unit is uploaded by the uploading unit to the client computer". The claims does not clearly teach how a "website notifies the website". For purpose of art rejection, said limitation would be interpreted as meaning "displaying electronic articles in a website".

Claims 48, 49, 54, 55, 62, 63, 77, 78, 84 and 85 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention. Previous claims recites "re-compiling the electronic articles". Nowhere, in the Applicant's specification said limitation is explained. For purpose of art rejection, said limitation would be interpreted as "updating the content of said electronic articles".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 44-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Jacobs (US 2004/0039784).

As per claims 44, 57 and 72, Jacobs teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 216-221);

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer (paragraph 152);

an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see paragraph 152);

a compiling unit that compiles the electronic articles extracted by the extracting unit; and an uploading unit that uploads the electronic articles compiled by the compiling unit to a predetermined website (see paragraph 148).

As per claims 45, 58 and 73, Jacobs teaches:

The apparatus according to claim 44, further comprising:

an advertisement extracting unit that extracts an advertisement from an advertisement database based on the electronic articles extracted by the extracting unit, wherein the compiling unit compiles the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit (see paragraph 100).

As per claims 46, 60 and 75, Jacobs teaches:

The apparatus according to claim 45, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by the advertisement extracting unit, or a second number of times an advertisement is compiled by the compiling unit (see paragraphs 109, 165-167); and

an accounting-fee calculating unit that calculates accounting fee incurred by an advertiser of an advertisement based on any one of the first number of times and the second number of times that correspond to the advertisement and are calculated by the number-of-times calculating unit (see paragraphs 109, 229-231).

As per claims 47, 61 and 76, Jacobs teaches:

The apparatus according to claim 44, further comprising a website notifying unit that notifies the website to which the electronic articles compiled by the compiling unit is uploaded by the uploading unit to the client computer (see paragraph 130).

As per claims 48, 62 and 77, Jacobs teaches:

The apparatus according to claim 45, wherein the compiling unit recompiles the electronic articles when any one of the electronic articles and the advertisement compiled by the compiling unit is updated (see paragraph 152).

As per claims 49, 63 and 78, Jacobs teaches:

The apparatus according to claim 48, further comprising a re-compilation notifying unit that notifies the client computer that a re-compiling of the electronic articles has been performed (see paragraph 152).

As per claims 50, 64 and 79, Jacobs teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 216-221);

a first receiving unit that receives a first specification from the client computer in response to the summary, the first specification specifying which electronic article is selected by the client computer (see paragraph 152);

a first extracting unit that extracts a plurality of electronic articles from the article database based on the first specification (see paragraph 152);

a first compiling unit that compiles the electronic articles extracted by the first extracting unit (see paragraph 152);

a second receiving unit that receives a second specification from the client computer in response to the electronic articles compiled by the first compiling unit, the second specification specifying which electronic article is selected by the client computer (see paragraph 150);

a second extracting unit that extracts a plurality of electronic articles from the article database based on the second specification (see paragraph 152);

a second compiling unit that compiles the electronic articles extracted by the second extracting unit (see paragraph 152); and

an uploading unit that uploads the electronic articles compiled by the second compiling unit to a predetermined website (see paragraph 152).

As per claims 51, 65 and 80, Jacobs teaches:

The apparatus according to claim 50, further comprising:

an advertisement extracting unit that extracts an advertisement from an advertisement database based on the electronic articles extracted by any one of the first extracting unit and the second extracting unit, wherein the first compiling unit and the second compiling unit compiles the electronic articles extracted by any one of the first extracting unit and the second extracting unit and the advertisement extracted by the advertisement extracting unit (see paragraph 152).

As per claims 52, 67 and 82, Jacobs teaches:

The apparatus according to claim 51, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by the advertisement extracting unit, or a second number of times an advertisement is compiled by any one of the first compiling unit and the second compiling unit (see paragraphs 109, 165-167); and

an accounting-fee calculating unit that calculates accounting fee incurred by an advertiser of an advertisement based on any one of the first number of times and the second number of times that correspond to the advertisement and are calculated by the number-of-times calculating unit (see paragraphs 109, 229-231).

As per claims 53, 68 and 83, Jacobs teaches:

The apparatus according to claim 50, further comprising a website notifying unit that notifies the website to which the electronic articles compiled by the second compiling unit is uploaded by the uploading unit to the client computer (see paragraph 130).

As per claims 54, 69 and 84, Jacobs teaches:

The apparatus according to claim 51, wherein the first compiling unit and the second compiling unit re-compiles the electronic articles when any one of the electronic articles and the advertisement compiled by any one of the first compiling unit and the second compiling unit is updated (see paragraph 152).

As per claims 55, 70 and 85, Jacobs teaches:

The apparatus according to claim 54, further comprising a re-compilation notifying unit that notifies the client computer that a re-compiling of the electronic articles has been performed (see paragraph 152).

As per claims 56, 71 and 86, Jacobs teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraph 216-221),

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by the client computer; an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see paragraph 152);

a compiling unit that compiles the electronic articles extracted by the extracting unit; and an article transmitting unit that transmits the electronic articles compiled by the compiling unit to the client computer (see paragraph 148).

As per claims 59 and 74, Jacobs teaches:

The method according to claim 58, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles compiled at the compiling is changed at the client computer (see paragraph 216).

As per claims 66 and 81, Jacobs teaches:

The method according to claim 65, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles compiled at any one of the first-article-compiling and the second-article-compiling is changed at the client computer (see paragraph 221).

Response to Arguments

5. Applicant's arguments filed 09/28/2005 have been fully considered but they are not persuasive. The Applicant argues that in Jacobs the user never gets to select either the Playlist or the advertisement to be downloaded and this is contrasted with the Applicant's claimed invention, in which users select necessary information from a among a lot of information stored in a database. The Examiner answers that the Applicant is arguing about limitations that are not stated in the claims. Nowhere, in the Applicant's claims is mentioned that a user selects advertisement, the claims recites that a client computer selects electronic articles. Jacobs teaches a client program which selects the advertisement to be displayed (see paragraph 152), similar to Applicant's claimed invention.

The Applicant argues that Jacobs does not teach transmitting a summary of a plurality of electronic articles. The Examiner answers that Jacobs teaches transmitting a playlist to a client computer, where said playlist allows a user to select advertisements (see paragraph 109), similar to Applicant's claimed invention.

The Applicant argues that in Jacobs, the software instantiates an advertisement download function that downloads advertisements from at least one remote source and this is to be contrasted with transmitting a summary of a plurality of electronic articles

stored in a database to the client computer. The Examiner answers that in Jacobs the software that downloads the advertisement is located in the client computer and said client software receives advertisements from a remote server (see paragraph 130), similar to Applicant's claimed invention.

The Applicant argues that Jacobs does not teach "receiving a specification from the client computer in response to the summary". The Examiner answers that in Jacobs the client software selects the advertisement to be displayed (see paragraphs 152-153), similar to the Applicant's claimed invention.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
November 19, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER